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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
KOTSIPOULOS, Thomas George)
Serial No.: 09/338,158)
Filed: June 22, 1999)
For: COUPON INSERTING APPARATUS)

REPLY BRIEF

REPLY BRIEF TO EXAMINER'S ANSWER
DATED DECEMBER 20, 2002

Dennis H. Ma
Reg. No. 46,890
ROPER & QUIGG
200 South Michigan Avenue
Suite 1000
Chicago, IL, 60604
(312) 408-0855

Attorney for Appellants

Dated: February 14, 2003

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re Application of:

KOTSIPOPOULOS, Thomas George

Serial No.: 09/338,158

Filed: June 22, 1999

For: COUPON INSERTING APPARATUS

Group Art Unit: 3721

Examiner: Eugene L. Kim

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

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APPELLANT’S REPLY BRIEF

Pursuant to 37 C.F.R. §1.193, Appellant submits this Reply Brief to the Examiner's Answer dated December 20, 2002. This Reply Brief is submitted in triplicate.

If any additional fees are required, please charge the deficiencies to our Deposit Account No. 18-1942. If a fee is required for an extension of time under 37 C.F.R. § 1.136 and such fee is not accounted for above, Appellant petitions for such an extension and requests that the fee be charged to the Deposit Account No. 18-1942.

ARGUMENT

In light of the Examiner's Answer, Appellant would like to direct the Board's attention to the timing signal issue specifically as it pertains to pending claims 6 and 8.

In the Examiner's Answer, under Grounds of Rejection, the Examiner argues that the combination of Roetter et al. (U.S. Patent 4,261,497) in view of Lewis et al. (U.S. Patent 4,468,912) inherently results in the coupon being removed at the appropriate/predetermined time.

(12/20/02 Examiner's Answer at p. 3). Appellant does not concede that Roetter and Lewis are properly combinable for the reasons given in Appellant's Appeal Brief. Even if *arguendo* Roetter and Lewis are properly combinable, Appellant notes that as pertains to pending claims 6 and 8, the Examiner has not addressed the issue raised in Appellant's earlier brief, namely that the Appellant's invention links the timing signal to the presence of the *container* rather than the presence of the next coupon.

The timing signal in Roetter is only directed to sensing the presence of a coupon in the bursting position, resulting in bursting at regular time intervals. Even if properly combinable with Lewis' coupon applicator, the combination would not result in the proper positive application of one coupon per container unless the containers were regularly spaced on the conveyor belt. The timing signal in Roetter is linked to the presence of the next *coupon*, rather than to the presence of a container to receive the coupon. Thus, any deviation from the proper spacing between the containers or a variation in the belt speed would lead the Roetter/Lewis apparatus to burst and attempt to apply coupons even when there was not a container to receive it. Put another way, even if there were no receiving containers, the Roetter/Lewis apparatus would continue to burst and attempt to apply coupons at regular intervals.

Invalidation based on inherency is not established by possibilities or probabilities. *Scaltech v. Retec/Tetra, L.L.C.*, 178 F.3d 1378, 1384 (Fed. Cir. 1999). The mere fact that positive coupon insertion would result if the containers happen to be properly spaced in coordination with the regularity in bursting by Roetter is not sufficient to establish inherency. *In re Oelrich*, 666 F.2d 578, 581-82 (CCPA 1981). Such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. *In re Rijckaert*,

9 F.3d 1531, 1534 (Fed. Cir. 1993).

By contrast, Appellant's invention links the timing signal to the presence of the *container*, rather than the presence of the next coupon. In doing so, Appellant's invention bursts and inserts a coupon *if and only if a container will be present to receive it*. Operation of Appellant's invention results in improved operational efficiency since containers need not be placed at precise predetermined intervals on a conveyor belt in order to achieve a positive insertion of one coupon per container. Moreover, the apparatus will not attempt to insert a coupon unless a container is present to receive it.

It is the Appellant's position that the linking of the timing signal to the presence of the container rather than the coupon is not taught or even addressed by Roetter or Lewis, alone or in combination. There is no motivation, teaching, or suggestion to combine Roetter or Lewis, nor has the Examiner proffered one. Moreover, inherency and obviousness are separate and distinct concepts. *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1555 (Fed. Cir. 1983).

CONCLUSION

Appellant continues to maintain the position asserted in its Appeal Brief of November 5, 2002. Respectfully, it is the Appellant's position that the Examiner's continued grounds of rejection have been addressed by the Appellant's prior Office Action responses and in the Appellant's Appeal Brief. Appellants submit that its main Appeal Brief addressed all relevant issues raised by the Examiner in his final rejection and the Examiner's Answer. Moreover, Appellants submit that for the foregoing reasons an apparatus using the supposed teachings of Roetter in view of Lewis do not inherently remove the coupon at the appropriate/predetermined time.

For the foregoing reasons and for the reasons stated in the Appellant's Appeal Brief of November 5, 2002, it is requested that the Board overrule the Examiner's rejections under 35 U.S.C. § 103(a).

Respectfully submitted,

ROPER & QUIGG

By: *Dennis H. Ma*
Dennis H. Ma
Reg. No. 46,890

ROPER & QUIGG
200 South Michigan Avenue
Suite 1000
Chicago, IL, 60604
(312) 408-0855

Dated: February 14, 2003

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Dated: February 14, 2003


Kim E. McCoy

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